

In the
United States
Circuit Court of Appeals
In and for the Ninth Circuit

MASICK C. MAGARIAN,	}
<i>Plaintiff-Appellant,</i>	
v.	
DETROIT PRODUCTS COMPANY, a	
copartnership composed of Floyd E. Wallace and Percy J. Elwell,	
<i>Defendants-Appellees.</i>	

Brief for Appellee

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Defendants-Appellees.

No. 9811

Brief for Appellee

The plaintiff-appellant has appealed from the holding by the Lower Court that the plaintiff's patents are invalid for lack of invention.

The Specifications of Error filed by the plaintiff-appellant and reproduced at pages 13 to 16 of appellant's brief attack the Findings of Fact and Conclusions of Law supporting the decision of the Lower Court. No useful purpose would be gained by attempting to answer all of the assertions and contentions raised in the appellant's brief. The controlling factor is that claim 1 of plaintiff's patent is anticipated by

Plaintiff's Exhibit A which was manufactured and sold more than two years prior to the filing of the plaintiff's application that matured into his patent.

Claims 3 and 4 are invalid for lack of invention over Plaintiff's Exhibit A and other prior art.

The plaintiff-appellant's design patent is likewise invalid for lack of invention over the prior art and for the further reason that the novelty, if any, in the design patent is dictated only by utilitarian considerations.

CLAIM 1 OF PLAINTIFF'S PATENT IS ANTICIPATED BY PLAINTIFF'S EXHIBIT A

Claim 1 of the plaintiff's patent reads as follows:

"1. In a lens mounting for a signal arm, two identical elongated plates having registering marginal flanges and spaced body portions with registering openings therein, lenses having flanges bearing upon the inner margins of the openings and having body portions projecting through the latter, a separator between the lenses and means for securing the flanges of the plates together, whereby the body portions of the plates are made to clamp the lenses upon the separator, the lenses having shaped inner faces to produce desired reflecting effects and the separator serving to prevent play between the lenses and the plates."

The plaintiff, himself, while under cross-examination testified (R. p. 70 and 71):

"Q. You were selling arms having that outer end like plaintiff's Exhibit A prior to November 16, 1935?

A. Yes, I started selling those in April or May of 1935."

The plaintiff's application was not filed until November 16, 1937. Consequently, Plaintiff's Exhibit A having been sold on the open market for more than two years by plaintiff prior to the filing of his application has been conclusively abandoned to the public and is part of the prior art. This is apparently conceded by appellant. (Appellant's brief, p. 22.) The plaintiff-appellant then testified (R. 71-73) as follows:

"Q. Now, in that outer end of the arm, Plaintiff's Exhibit A, you likewise have *a lens mounting for a signal arm*, do you not?

A. Yes, sir.

Q. It comprises *two identical elongated plates*, doesn't it?

A. Yes, sir.

Q. Those plates having registering—

A. The term elongated there, is slightly questionable. I don't want to say, it is exactly elongated, because it isn't. The term elongated don't apply to this, as well as the arm where you have a definite elongation. The word elongated may not exactly apply to this.

Q. In those plates you have in your hand, which are a duplicate of the outer end of Plaintiff's Exhibit A, are longer than they are wide, aren't they?

A. Yes, slightly longer.

Q. They have *registering marginal flanges*, don't they?

A. Yes.

Q. *And spaced body portions?*

A. Yes, sir.

Q. *With registering openings therein?*

A. Yes, sir.

Q. And you have lenses having flanges bearing on the inner margin of the openings?

A. Yes sir.

Q. In that outer end?

A. Yes sir.

Q. You have body portions of the lenses through the latter. That is, through the body portions of the plate?

A. Yes sir.

Q. Do you have a separator between the lenses in that outer end?

A. Yes sir.

Q. Do you have a means for securing the flanges of the plates together?

A. Yes sir.

Q. *Whereby the body portions of the plates are made to clamp the lenses on the separator?*

A. Yes sir.

Q. You have lenses having shaped inner faces to produce desired reflecting effects?

A. Yes sir.

Q. *And the separator serving to prevent play between the lenses and the plates?*

A. Yes sir."

We have italicized in the above quotation the wording extracted from claim 1 used in framing the ques-

tions. It is thus manifest from the plaintiff-appellant's own admission that each and every element of claim 1 is readable on Plaintiff's Exhibit A which is a part of the prior art. The only dispute that the plaintiff had was that in Plaintiff's Exhibit A the plates that formed the arrowhead at the outer end of the arm were not quite long enough to be regarded as "elongated." The issue thus quickly simmers down to a question of how long must the plates be to be "elongated." Plaintiff-appellant admitted in the above quotation that the plates were longer than they were wide. It is the defendant-appellees' contention that if the plate is longer than it is wide it is elongated. But even if not, the claim is anticipated for there certainly is no patentable novelty present in making the plates somewhat longer. In view of this testimony the Lower Court made the following findings (R. 17 et seq):

"7. More than two years prior to the filing of the plaintiff's application for United States Letters Patent, i. e. November 16, 1937, the plaintiff himself manufactured and publicly sold a signal arm exemplified by Plaintiff's Exhibit A.

"9. It was not new at the time of the plaintiff's alleged invention to manufacture signal arms having two identical elongated plates having registering marginal flanges and spaced body portions with registering openings therein, this feature being illustrated in plaintiff's Exhibit A and in the Elliott patent.

"10. It was not new at the time of the plaintiff's alleged invention to manufacture signal arms

with lenses having flanges bearing upon the inner margins of the openings and having body portions projecting through the openings in the plates, this being illustrated in plaintiff's Exhibit A.

"11. It was not new at the time of the plaintiff's alleged invention to manufacture signal arms with separators between the lenses or to secure the flanges of the plates together to cause the plates to clamp the lenses upon the separator, this being shown to be old in plaintiff's Exhibit A.

"12. It was not new at the time of the plaintiff's alleged invention to have the lenses of signal arms having shaped inner faces to produce desired reflecting effects or to have the separator preventing play between the lenses and plates, such shaped lenses being illustrated in plaintiff's Exhibit A and the utilization of the separator to prevent play being illustrated in plaintiff's Exhibit A."

The plaintiff's Specifications of Error 3, 4, 5, and 6 attack findings 9, 10, 11, and 12. It is submitted that in view of the above-quoted testimony of the plaintiff-appellant himself, that the Lower Court's findings are not only supported by "some evidence" but that the Lower Court could not have logically made any other findings. Plaintiff's Specifications of Error 3, 4, 5, and 6 are thus totally without merit and should be overruled. Furthermore, plaintiff-appellant's argument as to the validity of claim 1 (Appellant's Brief, pp. 37-39) which is at variance with plaintiff's own testimony above quoted must be regarded as frivolous.

The conclusion of the Lower Court that claim 1 of the plaintiff's patent is invalid should be promptly affirmed.

**CLAIM 3 OF PLAINTIFF'S PATENT IS LIKEWISE
INVALID FOR LACK OF INVENTION OVER
THE PRIOR ART.**

Claim 3 of plaintiff's patent reads as follows:

“In a direction indicator, a signal arm comprising a pair of elongated plates arranged face to face and having marginal flanges, the body sections of the plates being offset to define an elongated lens-receiving space, each of the body sections having an aligned series of openings therein registering with those of the other, lenses mounted in the openings of each body section and having flanges bearing on the inner faces thereof and a common separator for spacing opposing lenses, the separator being coextensive with the lens receiving space to facilitate positioning of the same during assembly.”

This claim differs from claim 1 only in the fact that it recites that each side plate is offset centrally “to define an elongated lens-receiving space, each of the body sections having an aligned series of openings therein registering with those of the other” and that the separator is “common” and “coextensive with the lens receiving space to facilitate positioning of the same during assembly.” In other words, this claim differs from claim 1 in duplicating the lenses and the lens-receiving

openings along the length of the arm, and arranging a common separator between the lenses. The Lower Court found:

“15. The use of a plurality of reflecting lenses in a row on the sides of a vehicle signal arm and the use of elongated lenses for this purpose at the time of the plaintiff’s alleged inventions was a mere matter of selection or option not amounting to invention, but instead mere mechanical skill.

“16. The use of a single separator between the lenses arranged in rows in opposite sides of the signal arm and the making of this separator so as to be coextensive with the lens receiving space provided by the plates of the signal arm at the time of the plaintiff’s alleged invention did not amount to invention but to mere mechanical skill.”

These findings of the Court are well supported by the evidence and the prior art. A signal arm having a plurality of reflecting lenses in a row did not originate with Magarian. Plaintiff’s Exhibit A not only had a large outer reflecting lens but it also had smaller inner reflecting lenses. All of the lenses were arranged in a row. Furthermore, the use of a plurality of reflecting lenses arranged in a row on a signal arm was old in the prior art. See the lenses 24 on Fig. 2 of the Reynolds patent, Bk. of Exhibits, p. 303. See also the lenses in the Carter patent, Bk. of Exhibits, p. 308. See also the reflecting lenses 8 in the British patent to Dennis, Bk. of Exhibits, p. 317. It is therefore manifest that the use of a plurality of reflecting lenses in a row on the sides of a vehicle signal arm was a mere

matter of selection or option and no invention would be involved in duplicating the reflecting lenses in the outer end of Plaintiff's Exhibit A. Even the defendants themselves had made and sold signal arms having a plurality of reflectors arranged in a row along the length of the arm as early as 1933 and 1934, see Defendants' Exhibit D. (R. 187.)

As to the use of elongated lenses for this purpose, this was likewise old in the art. The Costenbader patent, Bk. of Exhibits, p. 299, shows the use of elongated lenses 21 on signal arms to be old. Even the plaintiff, Magarian, himself does not claim to be the originator of elongated lenses. (R. 75.) The Lower Court's finding 15 is thus well supported by evidence.

Plaintiff's Exhibit A had the same character of lenses with a separator therebetween in the outer end of the arm. These might have been given any suitable shape. In other words, they might have been circular in form as they are, or they might have been given a square shape, a triangular shape, an oval shape, or an oblong shape. The particular shape of the lenses is a mere matter of option. Officials of the State of California recommended the use of as large a reflecting area as possible, according to Magarian's own testimony (R. 80):

“Q. You say somebody asked you to increase the size or the number of the lenses?

A. The officials in Sacramento thought it would improve the arm, by adding another lens, where your left hand is, about in that position, so

I made the four lenses, altogether, on each side.”

(R. 81):

“Q. Was August, 1934, when the State Officials told you they thought it would be better to increase the number of reflectors?

A. Yes.”

If there is any merit in increasing the number of reflectors or duplicating their presence along the length of the arm this idea did not originate with Magarian but was a requirement imposed by the officials of the State of California.

Walker on Patents, Deller's Edition, p. 205, states the general rule concerning duplication of parts as follows:

“It is not invention to duplicate one or more of the parts of a machine or a manufacture; unless the duplication causes a new mode of operation, or produces a new unitary result.”

Here, the duplication of the lenses and selecting oval-shaped lenses brings no new mode of operation and produces no new unitary result. There is merely a duplicated or increased reflecting area.

“In *Slawson v. Grand Street R. R. Co.*, 107 U. S. 649, 653, 27 L. Ed. 576, 577 (1882), the patented improvement consisted merely in putting an additional pane of glass in the fare-box of a street car, on the side next to the passengers, so that they could see into the box, as well as the driver, for whose use one pane of glass was already in the side of the box next to him. The Supreme

Court said that the putting in of that additional pane of glass required no more invention than the putting of an additional window in a room opposite one already there.”

Deller's Edition of Walker on Patents, p. 206.

Likewise here, the placing of additional lenses along the length of the arm required no more invention than the placing of the additional pane of glass in the fare-box of a street car or the putting of an additional window in a room opposite one already there.

Claim 3 recites:

“a common separator for spacing opposing lenses, the separator being coextensive with the lens-receiving space to facilitate positioning of the same during assembly.”

Exhibit A has its separator common to the opposing lenses and meets this feature of the claim. There is nothing in the specification describing that the separator is coextensive with the lens-receiving space to facilitate positioning of the same during assembly. In Fig. 5 of Magarian's patent the separator 27 is shown as being coextensive with the side plates and projecting beyond the lens-receiving space. Fig. 4 of Magarian's drawing would indicate that the separator 24 is coextensive with the *length* of the lens-receiving space. But there is nothing in the drawing nor in the specification to the effect that the separator in Fig. 4 is coextensive with the *width* of the lens-receiving space. This limitation that is present in claim 3 and which is emphasized in plaintiff-appellant's brief, pp.

32-35, has no foundation whatsoever in the original disclosure. In the words of this Court, in *Bailey v. Sears Roebuck & Co.*, 115 F. (2d) 904:

“This means that the more rapidly moving pointer is closer to the dial in appellant’s device than in the other one, *but this point was not advanced as a teaching of the patent. It is evidently an afterthought, as the Master held.*”

Likewise here, the fact that the separator was co-extensive with the lens-receiving space is not advanced as a teaching of the patent but is a mere afterthought.

The Miller patent, Bk. of Exhibits, p. 312, has a highway marker comprising a frame corresponding to Magarian’s opposed plates. In this frame there are aligned openings that receive lenses or reflectors 16 and 17. Between these lenses there is a separator 18 coextensive with the lens-receiving space. In duplicating lenses of Plaintiff’s Exhibit A along the length of the arm the natural thing to do would be to also duplicate the separators, and if the lenses were closely arranged, to make the separators integral with each other. This would be nothing more than what would be expected from a normal mechanic exercising mechanical skill.

That the mere unifying of separate separators into a single separator does not involve invention, see *Walker on Patents, Deller’s Edition*, p. 196, Sec. 34:

“Unification or Multiplication of Parts.

“Ordinarily, uniting several parts of an existing device into an integral construction, or in mak-

ing in several parts what was formerly in one, involves no more than the exercise of mere mechanical skill. (Citing cases.)

“It is not invention, also, merely to make in one piece what was formerly made in two.”

There would be no invention in placing the separator 18 of the Miller patent, Bk. of Exhibits p. 312, between the reflectors 8 of the arm shown in Fig. 4 of the Dennis patent, Bk. of Exhibits, p. 317. The natural way to do it would be to make one single separator to occupy the entire lens-receiving space, particularly in view of the fact that Miller contemplated that his reflectors 16 and 17 might become “cracked or otherwise broken into relatively large pieces.” (Page 1, lines 87 and 88.) If Miller’s reflectors were broken into large pieces each one would correspond to a separate reflector. Not only is the use of a separator shown to be old between a single pair of opposed lenses, as in Plaintiff’s Exhibit A and the Kimbrough patent, Bk. of Exhibits, p. 288, wherein the lenses are indicated at 10 and 11 and the separator indicated at 5, but the use of a plurality of reflecting devices on opposite sides of a single separator is exemplified in Defendants’ Exhibit I wherein the separator constitutes the body of the arm itself having a plurality of reflectors on each side.

There is no particular advantage in using a single separator common to all lenses in the arm. Magarian himself testifies that the only difference is that by using a separator made up of several parts some slight addi-

tional amount of labor is necessary in assembly. (R. 102.) Whether the separator is coextensive with the lens-receiving space or not, is of no particular advantage and instead is a mere matter of selection. Compare Fig. 4 of the Magarian patent with Fig. 5. In the former figure separator 23 terminates in length with the length of the lens-receiving space. In Fig. 5, separator 27 is as long as the plates. Whether the separator is made in one way or the other is a mere matter of option.

Findings 15 and 16 of the Lower Court are thus well supported by evidence. Specifications of Error 9 and 10 which attack them are without merit.

CLAIM 4 OF THE PLAINTIFF'S PATENT IS INVALID FOR LACK OF INVENTION

Claim 4 reads substantially the same as claim 3 with the additional recitation that "the faces of the body sections being parallel so as to exert uniform pressure on the interposed lenses and the separator." This added limitation does not render the subject matter of claim 4 patentable. Any mechanic would naturally endeavor to have the side plates of the arm hold the lenses snugly against the separator. Plaintiff's Exhibit A, which is a part of the prior art, has the body portions of the plates at the outer end of the arm parallel so that these portions will press the interposed lenses snugly against the separator. (R. 96-97.) Magarian admits that in Plaintiff's Exhibit A that the sepa-

rator serves "to prevent play between the lenses and the plates." (R. 73.)

It should be noted in passing that there is no disclosure in the specification of the Magarian patent that the body sections exert "uniform pressure" on the interposed lenses. This is candidly admitted by Magarian himself. (R. 95.) Whether or not the lenses would be pressed against the separator with uniform pressure would depend on whether the separator were of uniform thickness and whether the lenses were of uniform thickness. There is no disclosure of making the lenses and separator of uniform thickness in the Magarian patent and there consequently is no foundation in the Magarian specification for the last limitation in claim 4. This limitation seems to have been introduced into the application during its prosecution without being supported by a supplemental oath. In the words of *Bailey v. Sears, Roebuck*, supra, "It is evidently an afterthought, as the Master held." That a supplemental oath is necessary under these circumstances, see *Westinghouse E. & Mfg. Co. v. Metropolitan E. & Mfg. Co.*, 200 F. 661 (C. C. A. 2); also *Schick Dry Shaver v. R. H. Macy Co.*, 111 F. (2d) 1018 (C. C. A. 2).

CONCLUSION RE PLAINTIFF-APPELLANT'S MECHANICAL PATENT

Findings 5 to 12, inclusive, 15 and 16 (R. 17-20) are well supported by the evidence. The plaintiff-

appellant's Specifications of Error 3, 4, 5, 6, 9, and 10 are thus clearly without merit.

The plaintiff-appellant has stressed the fact that he pioneered the use of Stimsonite reflectors on signalling arms. Thus, at appellant's brief, page 7, he says:

"But it appears that no one prior to appellant's doing had ever applied the Stimsonite reflector to a signalling arm."

Page 8:

"Appellant must therefore be considered the one who pioneered the idea of making the Stimsonite reflector available for use in his signalling arm."

Page 6:

"Plaintiff's Exhibit A clearly proves along with other exhibits (Plaintiff's Exhibits K and O, Tr., pp. 270 and 271) that the plaintiff was the one who pioneered the idea of the Stimsonite lense on a signalling arm . . ."

Again at page 41, appellant asserts:

"Costenbader uses an ordinary reflector whereas appellant was the one to pioneer the idea of the Stimsonite reflector in connection with signal arms."

From these repeated assertions, and specification of error 19, apparently the appellant contends that he should be awarded the status of an inventor-patentee because of the fact that he was the first to recognize that the Stimsonite reflector was suitable for use on a

signal arm. However, the Stimson patent itself, Bk. of Exhibits, p. 294, column 1, lines 1 to 5 reads:

“This invention relates to reflecting devices and more particularly to reflecting devices of the character *designed for signalling* and aids to traffic.”

Certainly under these circumstances plaintiff-appellant cannot claim to be the pioneer in using the Stimsonite reflector on a signal arm. Instead, he merely exploited the proposal made by Stimson in his own patent as to how his reflectors were to be used. Furthermore, the selection of the Stimsonite reflector in preference to other reflectors seems to have been suggested by the officials of the State of California rather than to have originated with Magarian. Wallace testified that it was at the suggestion of Mr. Sharkey of the State Motor Vehicle Department that he wrote to the Guide Lamp Company to obtain Stimson reflectors. (R. 221.) He describes his conversation with Inspector Sharkey at R. 219. Magarian himself received recommendations from the State Officials according to his own testimony. (R. 83.)

No one is entitled to a patent merely because he is the first to commercially exploit proposals made in a prior patent or the suggestions made by State Officials. It is therefore submitted that the plaintiff's contention that his patents should be upheld by reason of his having pioneered the use of Stimsonite reflectors on signal arms cannot be sustained.

The plaintiff-appellant also emphasizes the use of elongated lenses or oval-shaped lenses, and attacks in Specification of Error 8 the Court's finding 14. Magarian testified (R. 106) that "the State law requires at least an illuminated portion of about twelve inches" on a signal arm. To secure such an illuminated length could be accomplished by either a long series of individual round reflectors or a smaller number of elongated reflectors. Magarian testified (R. 106) that use of his three reflectors was all that was necessary to secure this illuminated length. The defendants secured the same illuminated length with only two reflectors, these being elongated. Magarian testified (R. 75):

"Q. You don't claim to be the originator of elongated lenses, do you?

A. No sir."

Manifestly, he could not, for the use of elongated reflectors or lenses on a signal arm is old in the prior art. Costenbader, Bk. of Exhibits, p. 299, clearly shows the use of elongated lenses 21 on opposite sides of a signalling arm. The Reynolds patent, Bk. of Exhibits, p. 303 at page 305, column 1, line 30 et seq, said:

"If two glasses are used they would be in alignment as shown whereas if but one is employed it would preferably be of *an elongated shape* and disposed longitudinally of the arm."

The Dennis patent at Bk. of Exhibits, p. 325, says:

“Any type of reflector may however be used and may be adapted to give a variable reflection”

Manifestly, there would be no invention in selecting an elongated reflector as disclosed in the Costenbader and Reynolds patents in place of the circular reflectors in the Dennis patent, nor would there be any invention in having such elongated reflectors equipped with the prismatic back of the Stinson patent in order to get the desired reflecting effects. Particularly would this be true when State Officials were requiring an increase in the number of reflectors as testified by Magarian. (R. 81.)

“Q. Was August, 1934, when the State Officials told you they thought it would be better to increase the number of reflectors?

A. Yes.”

Finding 14 of the Court is thus well supported by the evidence and plaintiff-appellant's Specification of Error 8 is thus without merit.

Appellant's Specification of Error 7 attacks the Court's finding 13. In the Court's finding 13 it is found that it was not new at the time of the plaintiff's alleged invention to have a signal arm composed of identical elongated plates having raised center portions and marginal flanges with reflectors mounted in a row along the length of the raised center portions, these being shown to be old in Defendants' Exhibit D.

The most casual inspection of Defendants' Exhibit D which was found by the Court to have been manufactured and sold by the defendants from 1931 to 1935, in finding 6, demonstrates that finding 13 is strictly in accordance with the evidence. Plaintiff-appellant's Specification of Error 7 is thus without merit.

The plaintiff-appellant asserts that his claims are drawn to a novel combination arguing at page 28 of his brief:

“This claim, no doubt, recites a genuine combination, in which each part performs its function in cooperation with the other parts, and therefore, is not subject to piecemeal anticipation. There is no element or part in this claim which stands off by itself and would add merely an aggregative, unrelated feature. *By all the rules of our Patent Law, it would seem to be necessary to show that a single prior art structure discloses a combination of substantially the same elements or the equivalents thereof.*”

The plaintiff's assertion that it is “necessary to show that a single prior art structure discloses a combination of substantially the same elements or the equivalents thereof” is fully answered by this Court in *Mettler v. Peabody Engineering Corporation*, 77 F. (2d) 56, wherein this Court quoted from *Eagle et al v. P & C Hand Forged Tool Company* as follows:

“It is not necessary that all of the elements of the claim be found in one prior patent. If they are all found in different prior patents and no new functional relationship arises from the combina-

tion the claim cannot be sustained. *Keene v. New Idea Spreader Co.*, 231 F. 701; see also *Keszthelyi v. Doheny Stone Drill Co.*, 59 F. (2d) 3.

“All of the elements of the patent in suit were present in the prior art and combining these elements to make the patented device did not involve invention. Widespread use of the device combining these elements old in the art is evidence of its utility but is not conclusive of its patentable novelty.”

Here, all of the elements are old in the prior art. In the pretrial conference referred to by the plaintiff-appellant at page 12 of appellant's brief, the Court specifically asked appellant's counsel whether or not all of the elements in the plaintiff's patent were old in the art. At that time plaintiff-appellant's counsel candidly admitted that all of the elements were old in the art. This admission was quite proper. A signal arm composed of opposed identical plates having marginal flanges and raised center portions was old in the Elliott patent, Plaintiff's Exhibit A, and Defendants' Exhibit D as well as the Dennis patent, Fig. 4. The use of elongated reflectors was old in the Costenbader patent and in the Reynolds patent. The use of reflectors having prismatic backs was old in the Stimson patent. The use of a separator between the lenses on opposite sides of the signal arm was old in Plaintiff's Exhibit A and in the Kimbrough patent.

All that the plaintiff has done is to bring these old features together into a new signal arm wherein each part functions in the same manner as it did heretofore.

Thus, the Stimsonite reflectors function the same way in which all Stimsonite reflectors function. The separator functions in the same way that it does in Plaintiff's Exhibit A. The plates function in the same manner as they did in Plaintiff's Exhibit A, the Elliott patent, and Defendants' Exhibit D.

The plaintiff's contention that his device has supplied a long-felt want and was a commercial success and that it was a patentable combination of old parts is fully answered by this Court in *Bailey v. Sears, Roebuck & Co.*, supra, as follows:

"Appellant argues that his device supplied a 'long felt want'; that it was a 'commercial success'; that it was a patentable 'combination' of old parts; that it was a 'new structure' producing 'new functions and results'; that it was not a movement measuring device but an indicating device. It is claimed that all these indicia of an invention were present in the appellant's patent.

"These points, it is true, are all some evidence of invention, but commercial success and utility are not conclusive in favor of invention and can be overcome by clear proof of lack of invention. (Citing cases.) There is no new function performed by the combination. The function performed was merely to indicate the location of the rotor blades, as in prior devices. Hence it was not patentable as a combination of old elements. (Citing cases.) What we have here is an aggregation of parts assembled by mere mechanical skill."

This disposes of specifications of error 11 and 13-19 inclusive. The Lower Court should be affirmed not

only in its Findings of Fact, but in its Conclusions of Law drawn therefrom to the effect that the plaintiff's patent is invalid for lack of invention over the prior art.

THE DESIGN PATENT IS INVALID AND NOT INFRINGED

The general shape of Magarian's arm is an old one. The outline of the arm is old in the Reynolds patent, Bk. of Exhibits, p. 303, and the Pohlman patent No. 1,744,794 transmitted as a physical exhibit. Both of these patents show signalling arms with pointed outer ends similar to that of Magarian.

The use of elongated lenses on a signalling arm arranged in alignment thereon is suggested not only by the Reynolds patent and the Costenbader patent, but see also the British patent to Corber No. 152,071, also transmitted as a physical exhibit. This patent discloses a signalling arm having two elongated lens openings arranged in alignment as shown in Fig. 7. The specification reads, page 3, column 1, lines 19 et seq:

“The casing D has two windows ee in its rear side wall which may be filled in with red glass or other red material whereby the light from the lamp D may cause a red light to be shown to the rear.”

The defendants' use of two elongated lenses on the sides of the arm was not copied by the defendants from the appellant's three-lens arm but instead seems to

approach the Corber arrangement closer than Magarian's design patent.

At pages 41 and 42 of the appellant's brief, the appellant seeks to distinguish his design from Costenbader by the fact that he uses Stimsonite reflectors and that in Costenbader and Defendants' Exhibit D the reflectors are mounted on the outside of the plate instead of on the inside. These differences in the shape are dictated by and controlled by utilitarian considerations. In *Applied Arts Corporation v. Grand Rapids Metalcraft Corp.*, 67 F. (2d) 428 (C. C. A. 6), the Circuit Court of Appeals said, page 429:

"It has been held, however, that a design patent stands on as high a plane as utility patents, *Knapp v. Will & Baumer Co.*, 273 F. 380 (C. C. A. 2); *Cahoone Barnet Mfg. Co. v. Rubber et al.*, 45 F. 582 (C. C. N. J.), and that on the issue of infringement a design patent is not infringed by anything which does not present the appearance which distinguishes the design claimed in the patent from the prior art"

Page 430:

"it appears to us that while there is some similarity between the patented and the alleged infringing designs, which without consideration of the prior art might seem important, yet such similarity as is due to common external configuration is no greater, if as great, between the patented and challenged designs as between the former and the designs of the prior art."

Page 430:

“To hold that general configuration made necessary by function must give to a patented design such breadth as to include everything of similar configuration, would be to subvert the purpose of the law”

In the case of *Man-Sew Pinking Attachment Corporation v. Chandler Machine Company*, 33 Fed. Supp. 950, non-infringement was found because

“Such similarity as exists is due to the functional requirement of this type of pinking machine.”

Weisgerber v. Clowney, 131 F. 477, 480:

“the attempt to patent a mechanical function, under cover of a design, is a perversion of the privilege given by the statute. Rowe v. Blodgett & Clapp Co., 112 Fed. 61, 50 C. C. A. 120; Marvel Co. v. Pearl (C. C.) 114 Fed. 946; Eaton v. Lewis (C. C.), 115 Fed. 635.”

In *Ex Parte Kern*, Decisions of the Commissioner of Patents for 1903, at page 292, the Commissioner said:

“In the consideration of this case it becomes necessary, first, to withdraw those elements which are included for the performance of a mechanical function. . . . So far as this design possesses any peculiarity of appearance, due to configuration created and employed for the performance of a mechanical result—that is to say, by which

it fits the place where it is to be used—such appearance must be eliminated from consideration of this subject-matter as an ornamental design.”

Another decision of the Commissioner of Patents which has an extremely close parallel to the facts of this case is *Ex Parte McGowen*, 336 O. G. 3, decided by the Commissioner of Patents on December 16, 1924. In that case the applicant had filed an application for a mechanical patent and on the same day had filed an application for a design patent on an automobile bumper. Here, Magarian filed on the same day an application for a mechanical patent and an application for a design patent, both being on another automobile accessory, to wit., a signalling arm. The Commissioner said:

“The present application was filed on February 9, 1924, and on the same day applicant filed an application for a mechanical patent, Serial No. 691,665, in which Figure 1 of the drawing seems to be identical with the figure of the present application. In Serial No. 691,665, applicant carefully explains each detail of his device and shows that each is adopted for a functional purpose. Referring to the rib extending throughout the length of the device, he says:

‘The bead 1a serves as a protection for the body portion of the bar 1 in that it constitutes an impact receiving device wherein distortion will take place, when obstructions such as posts or walls are encountered.’

“Under somewhat similar circumstances the court refused to sustain a design patent for a tumbler having a protecting rib in *Ferd Messmer Mfg. Co. v. Albert Pick & Co.*, 251 Fed. 894. The particular shape chosen for this reinforcing portion does not lend patentability in view of *Backstay Machine & Leather Co. v. Hamilton*, 278 O. G. 710, 1920 C. D. 397; 262 Fed. 411.

“Applicant in Serial No. 691,665 points out that the flanges being widened towards the center provide—

. . . ‘stronger sections towards the middle portion of the bar where the greatest strength is required, thus also effecting a saving in material without substantially reducing the effective strength of the bar.’

“He also points out that the form and arrangement of the springs are such as to more effectively absorb shocks. (*Ex parte Marsh*, 1924 C. D.; 322 O. G. 501.)

“In application Serial No. 891,665 applicant has claimed structurally substantially each of the five elements relied on here as differentiating from the prior art. The claims have been rejected there and a design patent must be refused. ‘It is not true that the design (patent) can ever be used to appropriate (per se) the mechanical function.’ (*Baker v. Hughes-Evans Co.*, 270 Fed. 97. See also *Majestic Electric Co. v. Westinghouse Electric Co.*, 276 Fed. 676.) The slight differentiations made by applicant from the prior art can not support a design patent.’” (Parantheses quoted.)

In *Strauss Gas Iron Co. v. William M. Crane Co.*, 235 F. 126 (C. C. A. 2), Judge Learned Hand said:

“The modifications of these forms into the design patent does not seem to us to have been dictated by other than utilitarian considerations.”

Here, as in the McGowen case, *supra*, Magarian filed two applications on the same day. In his mechanical patent he sets forth the mechanical reasons for selecting the Stimsonite reflector, the use of the identical body plates with the marginal flanges, and the use of the separator. The resulting article accordingly has the shape illustrated in Fig. 2 of the mechanical patent, Bk. of Exhibits 264, which is virtually reproduced in its entirety as Fig. 1 in the design patent. There is nothing in the design patent pertaining to the use of Stimsonite lenses over the Costenbader lenses. In fact, the details of construction of the signal arm are not even described in the design patent. Magarian, by emphasizing the superiority of Stimsonite reflectors over Costenbader's (appellant's brief, p. 41), is attempting to cover under the guise of a design patent the shape that results when he adopts the selected mechanical features from the prior art. The answer to this effort is to be found in *North British Rubber Co. Limited v. Ronne Rubber Tire Co.*, 271 Fed. 936, 939:

“This patent is a plain effort to secure, under the guise of a design, a monopoly of the mechanical excellences thought to inhere in the peculiar arrangement of ridges and hollows. . . .”

Magarian's design patent is likewise a plain effort to secure under the guise of a design a monopoly of

the mechanical excellences thought to inhere in using Stimsonite lenses on a signal arm in place of Costenbader's lenses or lenses as in the Elliott patent. The Lower Court properly held the patent to be invalid.

A valid design patent cannot be secured for merely assembling old visual elements such as Magarian has done here.

General Electric Co. v. Parr Electric Co., 98 Fed. 2d, 60 (C. C. A. 2.)

But even if the design patent should be regarded as valid it is not infringed. The defendants' arms use only two lenses on each side. These are highly elongated, being considerably longer than any one of the Magarian lenses. Each of these elongated lenses has a pointed outer end. The patented arm on the other hand, discloses three lenses on each side, all of which are shorter and none of which are pointed. No ordinary human being would ever confuse one with the other. The test of infringement of a design patent as laid down by the Supreme Court and adopted by this Court in *National Nut Company of California v. Sontag Chain Stores Co., Ltd.*, 107 F. (2d) 318, is as follows:

"The Design Patent.

"We will first consider the suit on the design patent. Defendant in its answer denied infringement and alleged its invalidity because the design was not ornamental and was only incidental to mechanical construction of the machine disclosed

in the reissue patent. The trial court had before it models of the plaintiff's device and the alleged infringing device, and found no infringement. It was therefore unnecessary for the court to pass on the defense of invalidity. At the argument on appeal this court also had before it the models of the two machines, and from an examination thereof we agree with the trial court that defendant's machine does not infringe plaintiff's design patent.

"In the case of *Grelle v. City of Eugene*, 221 F. 68, 71 (C. C. A. 9, 1915), we quoted from the leading case on the subject of design patents, *Gorham v. White*, 14 Wall. 511; 20 L. Ed. 721, as follows:

'If, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same—if the resemblance is such as to deceive such an observer, and sufficient to induce him to purchase one, supposing it to be the other—the one first patented is infringed by the other.'

"This test has been uniformly followed in cases involving design patents. See cases cited in *Grelle v. City of Eugene*, supra. See also, *Eloesser-Heynemann Co. v. Kuh Bros.*, 297 F. 831, 833 (C. C. A. 9, 1924) and cases cited therein.

"Applying the quoted test to the design patent involved herein and the alleged infringing machine, we hold with the trial court that the design patent is not infringed, even if valid."

Magarian testified (R. 106) :

“Now, Mr. Magarian, have you ever received any orders for purchasers for signal arms having two lenses on each side, oblong lenses ?

A. Received any orders ?

Q. Yes.

A. No I never remember receiving any orders of that type.

Q. You have never mistaken your signal arm for the Detroit arm, have you ?

A. From a distance, yes, where it is used on the trucks because from a distance of about one hundred and fifty to two hundred feet, the lenses blend in together, and you see a continuous reflective area because these narrow portions here are rather small and they get lost and blend in. From a distance, yes, you can confuse them ; right close I can tell myself.

Q. Have you ever encountered any purchaser that confused the two signals in making his purchase ?

A. What form would I encounter ?

Q. I don't know. I just asked you, have you encountered anyone ?

A. No, not myself.”

Magarian himself is thus able to readily distinguish between the plaintiff's and defendants' signals. It is only when the signals are on trucks one hundred and fifty to two hundred feet away when he experiences difficulties. This is not the manner in which the ordinary observer or the prospective purchaser referred

to in *Gorham v. White* would view the signal. Magarian never received any orders from any purchaser who was deceived into believing that Magarian was manufacturing defendants' signals and he never encountered any purchaser who was confused by the signals in making his purchase. Moreover, the plaintiff-appellant did not call a single witness to show that any "ordinary observer" (purchaser) had been confused and from this fact it should be presumed by the Court that no one has been confused. The situation here is somewhat similar to that of *American Fabrics Co. v. Richmond Lace Works*, 24 F. (2d) 365 (C. C. A. 2) where the Court pointed out that there was no "disinterested testimony that ordinary buyers had made mistakes or are likely to."

If we regard the Western Auto Supply Company as being a typical purchaser according to Magarian's own witness, Lynn, that concern closely scrutinizes articles of this character that are submitted to the extent that they notice the superior finish or paint job on the Detroit arm over the Magarian arm. (R. 123-124.) Manifestly, if the average purchaser pays sufficient attention to the article to notice the difference in the finish paint job it certainly would notice the difference in the number of the lenses. He would also notice that the defendants' lenses were pointed whereas the plaintiff's were not and the fact that defendants' lenses were longer than the plaintiff's lenses.

It is to be observed that the burden of establishing infringement lies with the plaintiff. There is a notice-

able failure on his part to produce any evidence supporting the charge of infringement of the design patent.

As to the opinion of the industry, we have but to refer to the letter of the Guide Lamp Corporation quoted at Rec. 220. As set forth in this letter, Guide Lamp Corp., who supplies Stimsonite lenses to the trade generally, did not wish to make lenses for the defendants similar in size and shape to Magarians, because of the patent numbers appearing on Magarian's arm. That concern did, however, regard the shape that was ultimately adopted by the defendants as being sufficiently different from Magarian's lenses to justify the Guide Lamp Division manufacturing and selling the defendants' pointed lenses without danger of infringement or of contributory infringement.

We therefore say that even if the plaintiff's design patent is valid, which is being as charitable as we can be, the defendants' arms do not infringe and that the plaintiff has not carried the burden of proof of establishing infringement.

At the bottom of page 50 of appellant's brief, appellant apparently realizes that it has not carried the burden of proof of infringement and asserts "such confusion would be exceedingly difficult to prove." Near the bottom of page 51 of appellant's brief, he proceeds to argue how confusion might arise. However, there is an utter lack of evidence to establish that there has been any confusion. In discussing the design patent the plaintiff-appellant asserts at page 43 of his brief that he will confine himself principally to the case of *Forestek*

v. Knapp-Monarch Co., 106 F. (2d) 554. He quotes copiously from the decision. In view of the vigorous dissenting opinion in that case pointing out the inconsistency between the holding of the majority and the holding of the same Court in earlier cases, it is manifest that the Forestek decision must be restricted to its particular facts. It has, therefore, little if any bearing on the facts presented in this controversy.

OTHER DEFENSES

The foregoing argument should dispose of this case on its merits. However, for the sake of completeness the attorneys for defendants feel obliged to present before this Court all of the available defenses, particularly as some of them have been discussed by the plaintiff-appellant at pages 53 et seq of the Appellant's Opening Brief. These defenses are

(1) The plaintiff is guilty of unclean hands as alleged in the Answer, paragraph G (R. 9, 10, and 11) in that

(a) he suppressed all evidence as to the existence of Plaintiff's Exhibit A before the Patent Office;

(b) that when he placed his own article on the market he undertook to represent to the public that his signal arms were patented by seven patents, the numbers of which were listed, whereas these numbers were not of patents belonging to plaintiff or under which plaintiff was a licensee but instead were patent

numbers covering the manufacture of Stimsonite lenses.

(2) There is a file wrapper estoppel which prevents Magarian from asserting that his patent covers defendants' construction.

(3) The Lower Court had no jurisdiction.

THE PLAINTIFF IS GUILTY OF UNCLEAN HANDS

Magarian is guilty of unclean hands in that he suppressed information as to his having marketed Plaintiff's Exhibit A for more than two years before he filed his application. The oath forming a part of his application asserts that his alleged invention had not been in public use or on sale in this country more than two years prior to the filing of his application. No information concerning Plaintiff's Exhibit A was ever divulged by Magarian or his attorney to the Examiner in the Patent Office. The Examiner was manifestly ignorant of its existence. If anyone was to supply this information it should have been Magarian himself because he was the one who made and sold Plaintiff's Exhibit A more than two years prior to the filing of his application. Yet he kept entirely silent in this respect. Had he divulged to the Examiner that Plaintiff's Exhibit A was prior art, he could not possibly have secured the allowance of claim 1 of his patent which he now admits (R. 71-73) reads directly on Plaintiff's Exhibit A. Furthermore, when it came to answering defendants' interrogatories filed in the Lower Court he denied having made a construction embody-

ing features of Plaintiff's Exhibit A prior to November 10, 1935. It was only when he was forced to take the witness stand and was confronted with either admitting that he had made or sold Plaintiff's Exhibit A more than two years prior to the filing of his application and that it embodied features of his claims, or in the alternative denying this, as he had done in his interrogatory answers, and thus run the risk of being proven a prevaricator that he then elected to admit the truth. He consequently testified as he did at R. 71-73, above quoted. By his suppression of information as to Plaintiff's Exhibit A before the Examiner in the Patent Office he was able to prevail upon the Examiner to grant his claims which the Examiner certainly would have refused had he been in possession of information to the effect that Plaintiff's Exhibit A was prior art. Magarian has since used his invalid claims to harass and intimidate competition including these defendants, even going so far as to bring the present suit.

In *Keystone Driller Co. v. General Excavator Co.*, 290 U. S. 240, the plaintiff brought suit on five related patents. It was established that the plaintiff had been guilty of suppressing evidence concerning a prior public use which touched upon or affected the validity of at least some but not all of these patents. This conduct on the part of the plaintiff justified the Supreme Court in affirming a dismissal of the Bill of Complaint on all five patents because of the plaintiff's unclean hands. While the moral turpitude involved in that case may have been somewhat more aggravated than

here, this difference is merely a difference in degree and the principle in denying relief to a plaintiff guilty of unclean hands nevertheless applies.

The Bill of Complaint should therefore be dismissed on the ground that the plaintiff is guilty of unclean hands.

The appellant's attorney asserted at page 54 of his brief that this charge is too absurd to deserve serious consideration and that the allowed claims do not read on Plaintiff's Exhibit A. The assertion that the allowed claims do not read on Plaintiff's Exhibit A is quite contrary to Magarian's own testimony at Rec. 71 to 73. The charge deserves serious consideration for the reason that he who seeks equity must do equity, and this the plaintiff has not done by the deliberate suppression of information concerning Plaintiff's Exhibit A not only before the Patent Office but before the Lower Court in plaintiff's answers to defendants' interrogatories. These interrogatories and answers the appellant has not included in the record. As the answers to Magarian were so opposed to the truth, defendants were in no position to offer them in evidence. Consequently they have been in no position to demand their being included in the present record. We do reproduce in the appendix, however, defendants' interrogatory 7 and Magarian's answers thereto merely for comparison with his testimony (R. 71-73) as a matter of curious interest—rather than as having any weight in the decision of this appeal.

PLAINTIFF IS ALSO GUILTY OF UNCLEAN HANDS IN REGARD TO FALSE MARKING

Magarian did not stop with merely suppressing evidence in order to secure a patent with which he might harass the trade. On the signal arms he made and sold he applied a name plate bearing six or seven patent numbers. (R. 46.) These numbers were applied for the purpose of leading the trade and public to believe that Magarian's signal arm was covered by six or seven United States patents. None of these patents belonged to Magarian. He did not hold a license under them. All of the patents relate to Stimsonite lenses. (R. 46.) Magarian's excuse for applying the patent numbers to his plate was that the lenses he bought had the patent numbers molded on the back and when they were incorporated in his signal the patent numbers would thus be concealed. (R. 46-47.) But it was of no concern of Magarian's whether Stimson or the Guide Lamp Division was gaining the advantages of proper marking under the patent statutes. Guide Lamp Division knew that when they made the lenses they would be mounted in some kind of a holder and when so mounted only the convex portion disposed inwardly of the rim would be exposed. Guide Lamp Division nevertheless applied their patent numbers on the backs of the rims of the lenses which they knew would be concealed when the lenses were fitted in a frame or holder. This marking was sufficient for their purposes and it was of no concern of Magarian's whether the patent numbers on the lenses were con-

cealed or not. They were expected by Guide Lamp Division to be ultimately concealed.

The excuse of Magarian for prominently displaying these patent numbers on his signal arm is too flimsy. They were applied by Magarian for the purpose of creating the impression that his signal arm was patented and covered by these six patents. The plate on which the patent numbers are displayed was remotely located from the lenses and although Magarian says that it was "the only practical place I could put it in order to see the numbers," he did not have his plate read "Lenses covered by patents numbered, and". It was not until after Magarian was confronted with the allegations in Defendants' Answer that he even sought permission to apply the Stimson patent numbers to his signal arm. He produces a letter dated February 28, 1940 (long after this suit was filed), expressing no objection by Guide Lamp Division to the use of their patent numbers (R. 49), but when Magarian was asked to produce his own letter that sought the permission to use the patent numbers on his signal arm (R. 109) he promised to try to produce the letter but never did so.

Magarian's application of the Stimson patent numbers to his arm was designed to create the impression that Magarian's arm and not merely the lenses was covered by six United States patents. That he did create this impression is established by the letter quoted at page 220 of the Record. Magarian says in his brief, page 11, that the words "another customer" in this let-

ter referred to Magarian. We also believe that these words refer to Magarian. The letter reads:

“An inspection of the part in question reveals the fact there are many patent numbers listed on this article, and while we cannot state definitely if there are any patents on this particular design of lens, we are wondering if you would be interested in a lens of a different design in order that there will be no confliction between the lens you contemplate using and the one we are furnishing our customer.”

Guide Lamp Division did not even recognize that the numbers on Magarian's arm were the numbers of the patents covering its own lenses. It naturally assumed that the patent numbers on Magarian's arm referred to Magarian's patents on the arm. Manifestly, if the Guide Lamp Division was unable to recognize its own patent numbers on Magarian's signal arms, the trade and public would assume that the patent numbers referred to patents on the signal arm and not to patents on the lenses. This was exactly what Magarian expected the public to conclude. He sought to mislead the public into believing that his signal arm was covered by six or seven patents, when in fact it was not. Even Guide Lamp Division, who operated under these very same patents, was deceived. This unfair means used by Magarian to intimidate competition with relation to his signal arms is another reason for dismissing the Bill of Complaint because of unclean hands.

THE DEFENSE OF FILE WRAPPER ESTOPPEL

Claim 12 of Magarian's application ultimately resulted in claim 1 of his patent. This claim originally read as follows:

"In a direction indicator, a signalling arm, comprising two identical elongated plates having registering marginal flanges and spaced body portions with registering openings therein, lenses having flanges bearing upon the inner margins of the openings and having body portions projecting through the latter, a separator between the lenses and means for securing the flanges of the plates together whereby the body portions are made to clamp the lenses upon the separator."

By amendment this claim was amended to read as follows:

"In a lense mounting for a signal arm, two identical elongated plates having registering marginal flanges and spaced body portions with registering openings therein, lenses having flanges bearing upon the inner margins of the openings and having body portions projecting through the latter, a separator between the lenses and means for securing the flanges of the plates together whereby the body portions of the plates are made to clamp the lenses upon the separator."

The Examiner in acting upon the Magarian application said in paper No. 5, dated September 16, 1938:

"Claim 12 is rejected as unpatentable over Elliott of record. Elliott discloses two identical

elongated plates 21 having spaced body portions receiving a lens 22. The portions of the plates surrounding the body portions constitute registering marginal flanges as broadly stated in the claim. These flanges are secured together as shown in Fig. 2. The claim calls for nothing more than substituting a two-part lens for the unitary lens of Elliott and placing a suitable gasket or other separating means between the lens parts. Such modification of Elliott's device would produce no new and unexpected result.

"Claim 12 is further rejected as unpatentable over Elliott in view of Stimson, of record. No invention would be involved in substituting the reflecting lens of Stimson for the light transmitting lens of Elliott to obtain the expected result. It is considered an obvious expedient to arrange two reflectors in back-to-back relation in order to render the signal arm visible from either side thereof. It is merely a matter of choice whether a separating means is used."

Magarian acquiesced in this rejection and amended the claim to recite

"the lenses having shaped inner faces to produce desired reflecting effects and the separator serving to prevent play between the lenses and the plates."

Why the Examiner ever receded from his rejection despite the amendment is not clear. The Stimson reflector had the shaped inner faces that produced the desired reflecting effects and the separator of Kimbrough served to prevent play between the lenses and the plates, the plates being shown at 12 and 13 of the

Kimbrough patent. The situation here is not greatly different from that in *Tilden v. Standard Sanitary Mfg. Co.*, 28 F. Supp. 775:

“Needless to say, it is difficult to explain a mental attitude of the examiner. If this court knew precisely what problem he had in mind it would perhaps be persuaded by his disposition of the matter. It is apparent, however, from the above quotation that the examiner was not thinking about the same thing with which we are presently concerned. We do not know why he allowed claims 1 and 2, but rejected claims 3 and 4 on the basis of the Barr and Twyford patents.

“The original of claims 3 and 4 read as follows:

“The combination with a water closet bowl formed with a rearwardly extending shelf having upwardly facing slots, and a flush tank having its (a) bottom formed with semi-spherical chambers (projecting upwardly from the upper face of the bottom) and with slots that communicate with said chambers, of screw bolts to clamp the tank to the bowl, said bolts having T-heads adapted to be inserted upwardly into the said chambers, the bodies of said bolts thence extending downwardly through said shelf, means to prevent the bolts from rotating in said chambers, and means carried by the bolts and engaging the bottom face of the shelf to clamp the tank to said shelf.

“The combination with a flush tank having chambered portions cast on (and projecting upwardly from the upper face of) its bottom and having spots communicating with said

chambers, and a water closet bowl having a shelf at its rear end formed with slots that register with the opening of the tank, of clamping devices adapted to extend downwardly through the bottom openings of the tank and said shelf, said devices having enlarged portions that are disposed in and shielded from the flushing water by said chambered portion (and which seat upon the upper face of the tank bottom), means to secure said clamping devices to the bottom of the tank, and independent means to lock the lower ends of said devices to said shelf and to draw the tank towards the shelf.' (When the corrections and interpolations set forth in the parentheses were made the claims were allowed.)

“If claims 3 and 4 were rejected on the basis of prior patents it is incomprehensible to us that a rephrasing of the claims would add patentable invention where none existed before. Particularly is this true when the corrections and interpolations in the original claims amount only to a change in form and not in substance.

“With reference to the so-called presumption which attaches to the issuance of the patent, this court concludes that any significance attendant thereto has been neutralized.”

Likewise here, as claim 12 which ultimately matured into claim 1 of the Magarian patent was properly rejected on the basis of a prior patent and acquiesced in by Magarian, it is difficult to conceive what rendered the claim patentable by the amendment specifying the

shaped inner faces on the Stimsonite lens or that the separator served to prevent play between the lens and the plates. At all events, it is manifest that Magarian's claim 1 cannot be construed or interpreted to cover the same subject matter as that defined by original claim 12 the rejection of which was acquiesced in by Magarian.

Claims 3 and 4 differ from claim 1 and from original claim 12 that was rejected and amended by (1) specifying that there is a common separator coextensive with the lens-receiving space and that the parallel faces of the body sections "exert uniform pressure on the interposed lenses and the separator." As above pointed out, there is no foundation for these limitations anywhere in the original disclosure in this application. These limitations were introduced into the application as an afterthought. Furthermore the coextensive separator was an old feature in the art as admitted by Magarian (R. 76):

"Q. . . . but in this particular case, you have a coextensive separator, coextensive with the size and shape of your lens receiving space in that outer end of Plaintiff's Exhibit A?

A. Well, if you want to limit it in that way, yes."

Also, in considering the limitation in claim 4 relating to the uniform pressure, if it is true as plaintiff asserts that this was inherent in his disclosure, then it is likewise true that this feature is inherent in the construction defined by Magarian's original claim 12

which was rejected, the rejection acquiesced in, and the claim amended. That the allowed claim in a patent can never be construed to cover the same subject matter defined by a claim presented, rejected, and either cancelled or amended, see

Deller's Edition of Walker on Patents, page 1215, section 249, and the numerous cases cited therein.

JURISDICTION

The question of jurisdiction was consistently raised by the defendants in the Lower Court. The Lower Court ruled that it had jurisdiction. However, as the case was ultimately decided in favor of the defendants, the only reason why the defendants raise the question herein is for academic consideration.

The defendants reside at El Segundo, California, which is in the Southern District of California. The plaintiff resides in Fresno, California, which is also in the Southern District of California. This suit, however, was brought in San Francisco, the Northern District of California, on the theory that the defendants had a "regular and established place of business" in San Francisco. Mr. Mitchell represents the defendants in San Francisco in a very limited capacity. He also represents some twenty or twenty-one others in San Francisco in a like capacity. It is of considerable importance to ascertain whether Mr. Mitchell, by representing the defendants and the twenty or twenty-one others is conducting a regular and established place

of business in San Francisco, not only for these defendants but the twenty or twenty-one others that he represents so as to subject them to the jurisdiction of the Court for purposes of patent infringement suits. We therefore submit the question academically for the purpose of determining whether or not Mitchell, in performing the activities that he does for the various clients, is subjecting all of them to the jurisdiction of the Court in San Francisco for the purpose of patent infringement.

The defendants maintain a small supply of signaling arms that are warehoused at Mitchell's place of business for purposes of convenience in making deliveries of signals less than twelve in number. All larger orders that are taken for the defendants' signals are filled direct from El Segundo. (R. 171.) The defendants allow freight on twelve or more signals per order; hence this practice. (R. 171.) On smaller orders of less than twelve, these are frequently filled from the small stock maintained by Mitchell in San Francisco as a saving on freight, to secure promptness in delivery, and for purposes of convenience.

The orders are solicited by Mitchell's son who travels over Northern California soliciting orders not only for the defendants' signal arms but the merchandise of the twenty or twenty-one other manufacturers that Mitchell represents. The defendants pay no salaries to anyone in San Francisco or in the Northern District. (R. 178.) Orders taken are sent to El Segundo to the defendants for acceptance or rejection

as a general rule. The defendants do not have their name on the door of Mitchell's place of business. (R. 165, see Defendants' Exhibit O; see also R. 177.) The defendants are not listed in the telephone directory in San Francisco (R. 178); nor does their name appear on Mitchell's letterheads (R. 177); nor on his billheads. The defendants maintain no bank account in San Francisco, nor do they have access to Mr. Mitchell's place of business except during business hours when Mr. Mitchell permits them to enter. The defendants maintain no employees in San Francisco. Aside from his capacity as a sales agent, Mr. Mitchell is nothing more than a warehouseman insofar as these defendants are concerned, releasing small quantities of signals (twelve or less) either pursuant to small orders taken by his son or releasing the defendants' signals to jobbers recognized as such and to whom the defendants normally would extend credit.

When the plaintiff proposed buying a Detroit signal at Mr. Mitchell's place of business and used Hansen for this purpose, Mitchell testified (R. 175):

“I told this man it could not be sold to him but if he knew a jobber, we could sell it to the jobber.”

The sale was thus consummated.

We submit that under these circumstances defendants do not have a regular and established place of business at Mitchell's in San Francisco. The business of the defendants is making and selling signals. Certainly it is not a regular and established place of business at Mitchell's when a proposed purchaser,

such as Hansen, comes in and says "I want to buy a Detroit signal" and Mitchell replies "I can't sell it to you, you will have to go to a jobber." Mitchell's place of business is not a regular or established place of business of the defendants. There is no employee of the defendants, and none of the rent is paid by defendants. The defendants do not have their name on the door, and sales cannot be consummated there but have to be referred to jobbers.

The statute conferring jurisdiction was designed to enable patent infringement suits to be brought where the defendant has an established branch office or a recognized agency, or where in effect part of the defendant's business and infringement are being conducted. It is not believed that these defendants, or any one of the other twenty or twenty-one concerns that Mr. Mitchell represents have what amounts to a regular and established place of business at Mitchell's in compliance with the law. His place of business is eighteen or twenty by eighty feet outside measurements. (R. 164.) There he keeps certain stocks for the various concerns that he represents for the purpose of emergency orders. (R. 170.) It is well established that where a corporation employs a certain representative with an office room in New York City to solicit orders to be filled at their home office of the corporation in Missouri, paying him a small salary, commission on sales, and travelling expenses that such a corporation nevertheless does not have a "regular established place of business" in New York City within

the meaning of the statute. *Tyler v. Ludlow Saylor Wire Co.*, 236 U. S. 723, 59 L. Ed. 808. Mitchell's son operates somewhat in the same respect as the salesman did in the Tyler case. He solicits the orders and refers them to the home office of the defendants. However, he is not paid any salary nor any travelling expenses by the defendants. No office is maintained by defendants for him. The academic question presented is: Does the fact that Mitchell warehouses a small number of the defendants' signals for emergency purposes and for making small short deliveries in the case of small orders remove the facts of this case from the rule of the Tyler case and make the defendants have a regular and established place of business in San Francisco withing the meaning of the statute?

It is true that Mitchell delivered the signal to Hansen, that money was turned over to Mitchell by Hansen in payment for the signal. However, in making the delivery to Hansen and in accepting Hansen's money, Mitchell was merely acting in accommodation to the jobber, Scovel and Sons. He certainly was not acting with any authority from the defendants. If Mitchell had been authorized to sell the defendants' arms there would have been no object in his telling Hansen that he could not sell the arm to him, or in referring Hansen to a jobber such as Scovel and Sons. If Mitchell had been an agent of the defendants authorized to conduct business on behalf of the defendants in San Francisco, he would have been glad to sell the arm direct to Hansen himself and in so doing,

would have collected not only his warehouse fee but also a sales commission. The record, however, shows that Mitchell did not do this but instead referred Hansen to Scovel and Sons and then consummated the transaction as an accommodation to Scovel and Sons. The decision of this Court in *Wilson v. McKinney Mfg. Co.*, 59 F. (2d) 332, indicates that before jurisdiction should be assumed it should be clear that the jurisdictional facts are present. In this case the plaintiff apparently realized the weakness of his jurisdictional position and therefore proposed joining Mitchell as a party-defendant at the very moment that he took the witness stand. (R. 161, 162.)

The facts of this case compare closely with those of *General Electric Co. v. Best Electric Co.*, 220 F. 347:

“The sales agent is paid a commission of 7½ per cent on the amount of sales made by him or anyone else within this district and other territory. He is the agent for other manufacturers or dealers. He pays his own office rent, and does not display upon that office any sign indicating it is the business of the defendant. It keeps no stock of any kind in the district. Its agent does not do anything more than solicit orders. He is not authorized to accept them or to receive payment for them. All goods are shipped from its Pittsburgh office and factory and all payments are regularly made there. On one or two occasions when someone has wanted defendant’s goods in a hurry, or when for other reasons the agent did not choose to order the goods from the factory he went out and per-

sonally bought the goods from a New York jobber and sold them to his customer. It is very doubtful, under these circumstances whether the defendant is doing business in this district either generally or specially, in such sense as would render it liable to suit herein by the complainant residing here, and when the jurisdiction of this court was invoked on the ground of diverse citizenship only.”

To compare the case with the above, Mitchell’s son Myron Mitchell, is paid a commission on the amount of sales that he solicits for the defendants’ signal arms. Mitchell’s son works for Mitchell, not the defendants. Mitchell himself is the agent for other manufacturers and dealers, representing some twenty or twenty-one. Mitchell pays his own office rent. He does not display on his place of business any sign indicating that it is the place of business of the defendants. The only distinction between the present case and *General Electric v. Best* is that in the *General Electric* case no stock of any kind was kept in the district. In the present case, Mitchell does keep a small stock for the purpose of emergency orders and filling small orders, which are too small for the defendants to allow freight upon. In the *General Electric* case the representative when he received an emergency order went out and personally bought the goods from a New York jobber and sold them to his customer. In the present case, as Mitchell could not go out and buy the defendants’ arms from other jobbers in San Francisco, he, instead referred Hansen to a jobber and proceeded to supply a

signal arm from his warehouse stock so that the jobber could immediately fill the order. In so doing he delivered the signal to Hansen accommodating Scovel & Sons to this extent and accepted the money for it as an accommodation to Scovel & Sons.

The fact remains that the defendants do not have a regular and established place of business in San Francisco. Likewise all of the twenty manufacturers that Mitchell represents in addition to the defendants but in the same capacity should be held to have no regular and established place of business in San Francisco that would justify bringing suits against them for patent infringement in this district.

It is submitted, therefore, that it is of some academic importance not only to these defendants but to the other manufacturers represented by Mitchell to have judicially determined whether or not jurisdiction has been obtained in this case.

CONCLUSION

Claim 1 of the plaintiff's mechanical patent is clearly anticipated by Plaintiff's Exhibit A on the plaintiff's own admission.

Claims 3 and 4 are invalid as lacking in invention over Exhibit A and other prior art.

The design patent lacks invention over the art. Such differences as may exist between the plaintiff's design and the prior art are dictated solely by utilitarian considerations.

Even if the design patent were valid, it is not infringed by the defendants' construction which differs from it in appearance. There is no proof that anyone has been confused into buying the defendants' arm believing it to be plaintiff's. Furthermore, there is no apparent likelihood that such confusion would ever arise.

The Lower Court should therefore not only be sustained in its Findings of Fact but also in its Conclusions of Law.

The plaintiff is guilty of unclean hands in that he suppressed evidence as to Plaintiff's Exhibit A before the Examiner. Had the Examiner been aware of Plaintiff's Exhibit A as being part of the prior art very likely he would not have granted Magarian's patent at all. He is also guilty of unclean hands by applying to his signal arm the patent numbers of the Stimson patents with the manifest intention of causing the public to believe that these patents covered his signal arm whereas, as a matter of fact, they merely covered the Stimsonite lenses that Magarian purchased and incorporated in his signal arm. Even the manufacturer of the Stimsonite lenses was misled by the appearance of these patent numbers on the plaintiff's arm. The allowed claims of the plaintiff differ from those which were presented, rejected, and cancelled or amended in immaterial respects, and in some respects having no foundation in the patent application disclosure. They are not supported by a supplemental oath. They cannot be construed as covering the same

subject matter as a claim presented, rejected, and cancelled.

The Lower Court should not have taken jurisdiction of this case for the reason that the defendants do not have a regular and established place of business in San Francisco.

An affirmance of the decree of the Lower Court, which is manifestly just as between the parties, is respectfully urged.

Respectfully submitted,

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Appendix

APPENDIX

DEFENDANTS' INTERROGATORY 7 AND MAGARIAN'S ANSWERS THERETO

“Prior to November 16, 1935, did the plaintiff sell or cause to be sold, signal arms embodying any of the following features or constructions:

“(a) Two identical elongated plates having registering marginal flanges and spaced body portions with registering openings therein. A. No.

“(b) Lenses having flanges bearing on the inner margins of the openings. A. No.

“(c) The lenses having body portions projecting through the openings. A. No.

“(d) A separator between the lenses. A. No.

“(e) Means for securing the flanges of the plates together whereby the body portions of the plates are made to clamp the lenses upon the separator. A. No.

“(f) The lenses having shaped inner faces to produce desired reflecting effects. A. Yes.

“(g) The separator serving to prevent play between the lenses and the plates. A. Yes, as far as each individual separator is concerned.”

